

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Thanos Karras

Serial No.: 09/681,306

Filed: March 15, 2001

For: INTEGRATION OF MOBILE
IMAGING UNITS INTO AN
APPLICATION SERVICE PROVIDER
FOR DATA STORAGE AND
INFORMATION SYSTEM SUPPORT

Examiner: Bleck, Carolyn M.

Group Art Unit: 3626

Conf. No.: 9546

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Date

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiners:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: July 14, 2006

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REMARKS

The present application includes pending claims 1, 3-9, 11-14, 16-17 and 19-36, all of which have been rejected. The Applicants respectfully submit that the claims define patentable subject matter.

Claims 21-22 remain rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al., U.S. Pat. No. 5,891,035 ("Wood '035"). Claims 1, 4-5, 7-9, 11, 13-14, and 33-34 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evans, U.S. Pat. No. 5,924,074 ("Evans") in view of Wood et al., U.S. Pat. No. 5,851,186 ("Wood '186"). Claim 3 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Wood '186 and further in view of Wood '035. Claims 6, 12 and 16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Wood '186 and further in view of Rothschild et al., U.S. Pat. No. 6,678,703 ("Rothschild"). Claims 17 and 19-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background and further in view of Rothschild. Claim 23 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Wood '035 and further in view of Evans. Claims 24-32 and 35-36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and further in view of Rothschild and Wood '035. The Applicants respectfully traverse these rejections at least for the reasons previously set forth during prosecution and the following:

I. The Cited References Do Not Teach or Suggest a Mobile Imaging Unit

Applicants respectfully submit that none of the cited art teaches or suggests the limitations recited in the pending claims. Of particular interest to the Examiner was any correlation between the mobile ultrasound cart of Wood '035 and Wood '186 and the mobile imaging unit recited in the pending claims. See April 14, 2006 Office Action at pages 3, 5-6 and 8, June 14, 2006 Amendment and Response at pages 8-10 and February 8, 2005 Amendment and Response at pages 9-10. The Evans and Rothschild make no mention of a mobile imaging unit. See, e.g., June 14, 2006 Amendment and Response at pages 9-12. While the Wood references discuss a wheeled cart that may be rolled around a hospital, the pending claims recite a mobile imaging unit, which is described as a mobile facility adapted to be used a plurality of locations. See June 14, 2006 Amendment and Response at pages 8-10 and February 8, 2005 Amendment and Response at pages 9-10. The mobile facility is a vehicle that includes imaging equipment,

and the Applicant has gone to great lengths to explain this in the claims and in responses to the Examiner's rejections. *See, e.g.*, June 14, 2006 Amendment and Response at pages 8-10 and February 8, 2005 Amendment and Response at pages 9-10. The Applicant's specification supports a construction of a mobile imaging unit as a mobile facility or vehicle. *See* June 14, 2006 Amendment and Response at page 14. However, the Examiner appears to be glossing over or ignoring these claim amendments and remarks. *See* July 7, 2006 Advisory Action at page 2. These amendments and remarks should be allowed to distinguish the mobile imaging unit described and claimed in the present application from the wheeled cart of Wood '035 and Wood '186.

Therefore, the Applicant respectfully submits that claims 1, 3-9, 11-14, 16-17 and 19-36 recite patentable subject matter and are in condition for allowance.

II. The Examiner Improperly Interpreted Statements Highlighting Deficiencies and Needs in the Art as Admissions

The Examiner relies upon statements in the Applicant's Background as admissions of prior art. *See* April 14, 2006 Office Action at pages 11-13. In fact, the statements cited by the Examiner highlight the Applicant's attempts to illustrate the current problems and deficiencies in the art. *See* June 14, 2006 Amendment and Response at pages 12-13. Thus, the Applicant illustrates a need for solutions that are then described in the present application. The Applicant's statements of needs or deficiencies should not be construed as admissions of prior art.

Therefore, the Applicant respectfully submits that at least claims 17 and 19-20 recite patentable subject matter and are in condition for allowance.

III. The Examiner Incorrectly Applied Claim Construction Principles and Laws When Construing the Term "Mobile Imaging Unit"

In the Examiner's Advisory Action of July 5, 2006, the Examiner states that a description of various embodiments and use of conditional "may" language does not qualify as a description of the invention. *See* July 5, 2006 Advisory Action at page 2. The Applicant submits that these statements and interpretation of 35 U.S.C. 112 are incorrect. To satisfy the requirements of 35 U.S.C. 112, the Applicant must provide a written description of the invention to enable any person skilled in the art to make and use the invention. 35 U.S.C. 112 ¶ 1. The specification shall also set forth the best mode contemplated by the inventor of carrying out his or her invention. *Id.* The statute makes no requirement that a best mode must be highlighted or stated

as “required”, only that the best mode be sufficiently set forth. *Id.* Therefore, the Applicant respectfully submits that the Examiner’s interpretation of 35 U.S.C. 112 and her construction of the term “mobile imaging unit” as set forth in the patent specification and claims, and as discussed in the prosecution history, is incorrect. *See* June 14, 2006 Amendment and Response at page 14. A description of various embodiments and various alternatives is sufficient description of the meanings of mobile imaging units, and the Applicant is entitled to at least those disclosed embodiments and their equivalents. The claims are to be interpreted in light of the specification, and the Applicant is entitled to be his or her own lexicographer in defining and describing the claimed terms. The meaning of the term “mobile imaging unit” is clear in the specification to a person skilled in the art, and the Examiner should fairly rely on that meaning in interpreting the claims in view of the prior art. *See, e.g.*, MPEP 6801.01(o).

Therefore, the Applicant respectfully submits that the cited art, including Wood ‘035, Wood ‘186, Evans and Rothschild does not teach or fairly suggest the “mobile imaging unit” recited in the pending claims, and claims 1, 3-9, 11-14, 16-17 and 19-36 should be allowable.

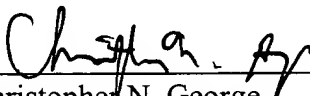
V. Conclusion

The Applicants respectfully submit that the claims of the present application should be in condition for allowance at least for the reasons discussed above and request reconsideration of the claim rejections. The Commissioner is authorized to charge any necessary fees, including the \$500 Notice of Appeal fee, or credit any overpayment to the Deposit Account of GTC, Account No. 502401.

Respectfully submitted,

Date: July 14, 2006

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